UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RAKESH K. PARIMI

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Appeal 2009-002832
Application 10/708,562
Technology Center 2100

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Decided: January 5, 2010

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Before LANCE LEONARD BARRY, JAY P. LUCAS and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the
Examiner's final rejection of claims 1-20. We have jurisdiction under
35 U.S.C. § 6(b) (2008).

We affirm.

STATEMENT OF THE CASE

THE INVENTION

Appellant's invention relates generally to automated testing of a system. More particularly, Appellant's invention is directed to an automated testing system, method and program product that generate a test map including unique test scripts depending on modules and interface points to be tested. (Spec. 1, para. [0001]).

Claims 1 and 9 are illustrative:

1.   A method for performing automatic testing of a system including a plurality of modules in which at least two modules lack a predetermined communication mechanism, the method comprising the steps of:

establishing at least one test goal for testing regarding at least one of a module and an interface point between modules;

providing at least one test script configured to conduct a test at each module and each interface point;

generating a test map for each test goal, each test map configured to run at least one test script for each module and each interface point in accordance with the test goal; and

automatically testing the system using each test map.

9.   A computer program product comprising a computer useable medium having computer readable program code embodied therein for performing automatic testing of a system including a plurality of modules in which at least two modules lack a predetermined communication mechanism, the program product comprising:

program code which, when executed by a computer system, is configured to enable the computer system to establish at least one test goal for testing regarding at least one of a module and an interface point between modules, wherein at least one test script configured to conduct a test is provided at each module and each interface point;

program code which, when executed by a computer system, is configured to enable the computer system to generate a test map for each test goal, each test map configured to run at least one test script for each module and each interface point in accordance with the test goal; and

program code which, when executed by a computer system, is configured to enable the computer system to automatically test the system using each test map.

PRIOR ART

Farchi   2003/0046613 A1   Mar. 6, 2003

THE REJECTIONS

1. The Examiner rejected claims 9-13 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

2. The Examiner rejected claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Farchi.

CLAIM GROUPING

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of representative claims 1 and 9. *See* 37 C.F.R. §41.37(c)(1)(vii) (2008).

APPELLANT'S CONTENTIONS

1.   Appellant contends that transmission media, e.g., a carrier signal, is recognized as a physical carrier. (Br. 4-5).

2.   Appellant asserts that Farchi does not disclose "providing at least one test script to conduct a test at each module and each interface point." (Br. 6). More specifically, Appellant contends that Farchi does not disclose that the system to be tested includes a module and/or an interface point, and does not disclose at least one test script for each module and/or interface point. (*Id.*)

3.   Appellant contends that Farchi does not disclose a "test map" as described in the specification. More specifically, Appellant contends that the test suite in Farchi does not disclose a sequence of the running of the test cases. (Br. 7)

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1.   Has Appellant shown the Examiner erred in concluding that claims 9-13 are directed to non-statutory subject matter under 35 U.S.C. §101.

2.   Has Appellant shown the Examiner erred in finding that Farchi discloses providing at least one test script to conduct a test at each module and each interface point? (Claim 1).

3.   Has Appellant shown the Examiner erred in finding that Farchi discloses a "test map" as claimed? (Claim 1).

PRINCIPLES OF LAW

CLAIM CONSTRUCTION

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

FINDINGS OF FACT

THE FARCHI REFERENCE

1.   Farchi discloses that behavior models are used in an "automated test generator to generate test cases that are combined to form the test suite." (Para. [0009]).

2.   Farchi discloses that "the program under test is tested by the test suite." (Para. [0010]).

3.   Farchi discloses that the test suite comprises one or more test cases for each component of interest. (Para. [0016]).

4.   Farchi discloses a client program for opening a connection to a server, with four distinct methods of making the connection. (Para. [0012]).

APPELLANT'S SPECIFICATION

5.   Appellant's Specification discloses that "[m]emory 22 (and database 30) may comprise any known type of data storage system and/or transmission media, including magnetic media, optical media, random access memory (RAM), read only memory (ROM), a data object, etc." (Para. [0026]).

6.   Appellant's Specification discloses that "[a] 'module' is a component of a system of interest." (Para. [0021]).

7.   Appellant's Specification discloses that "[a]n 'interface point' 14 is a point of communication between two modules 12. Each module 12 may interface or communicate with a wide variety of other modules 12 via interface points 14, which also may have different mechanical or electrical architecture and/or different control (software) platforms. Where an interface point 14 is a messaging protocol it may be based on, for example, CORBA, ORBIX, HTTP, FTP, MQ (pub/sub and point-to-point) or DB2. Each module 12 may have one or more interface points 14 depending on the other modules it must communicate with." (Para. [0022]).

ANALYSIS

Issue 1

§ 101 rejection

We decide the question as to whether claims 9-13 are directed to non-statutory subject matter.

Regarding claim 9, we note that a computer-readable medium having computer readable program code is directed to statutory subject matter so long as the language of the claim is not supported in the Specification with non-statutory embodiments (e.g., signals, transmission mediums and the like). *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) (A claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101).

In the present case, Appellant's Specification discloses that the computer readable medium is intended to broadly encompass transmission-type media. (FF 5). Because Appellant's claims broadly read on non-tangible transmission mediums, we conclude that the scope of independent claim 9 encompasses non-statutory subject matter.[1] Therefore, we sustain the Examiner's rejection of claim 9 and dependent claims 10-13 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Issue 2

Limitations under § 102

We decide the question of whether Appellant has shown the Examiner erred in finding that Farchi discloses providing at least one test script to conduct a test at each module and each interface point. (Claim 1).

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[1] "The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *Nuijten,* 500 F.3d at 1354.

Based upon our review of the evidence, we agree with the Examiner's findings with respect to this limitation. (Ans. 7-8). In particular, we find that Farchi discloses a client program for opening a connection to a server, with four distinct methods of making the connection. (FF 4). Therefore, since the claimed "module" is broadly described by Appellant's Specification as "a component of a system of interest" (FF 6), we find that Farchi discloses a test script (client program) to conduct a test at each module (e.g., client, server) and the connection ("interface point") between the two modules, as claimed. We note that Appellant's Specification broadly describes "[a]n 'interface point' 14 [a]s a point of communication between two modules 12." (FF 7). Therefore, we find Appellant has not shown error in the Examiner's prima facie case of anticipation regarding this limitation.

Issue 3

Limitations under § 102

We decide the question as to whether the Examiner erred in finding that Farchi discloses a "test map," as claimed. (Claim 1).

Appellant acknowledges that "[t]he test suite in Farchi includes test cases to achieve test tasks." (Br. 7, ¶1). However, Appellant argues forcefully in the Brief that a "test map" is "a <u>sequence</u> of stored test cases to be run in <u>sequence</u> for each module and interface point in accordance with a test goal." (*Id., emphasis added*). In particular, Appellant contends that Farchi does not disclose a <u>sequence</u> of the running of the test cases." (*Id.*).

We note that the argued "sequence" is not recited in any of the claims before us on appeal. Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in ex parte prosecution it must be

within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Here, we find the portion of the Specification pointed to by Appellant is merely exemplary of a preferred embodiment and does not provide a person of ordinary skill in the art with clear and precise notice of the meaning argued by Appellant in the Brief.

We also note that Appellant could have amended the claims during prosecution to recite *a sequence of stored test cases to be run in sequence for each module and interface point in accordance with a test goal* instead of the presently recited "test map" that is merely "configured to run at least one test script for each module and each interface point in accordance with the test goal;" (Claim 1). However, Appellant chose not to amend the claims.

Because "applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (*citing In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

Here, we decline to read the argued limitation of "a sequence of stored test cases to be run in sequence for each module and interface point in accordance with a test goal" into the claims. (Br. 7, ¶1). "[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (*citing In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Consistent with Appellant's Specification, we broadly but reasonably construe the argued claim term "test map" as reading on *any* program *configured to run* one or more test scripts for each module and each interface point in accordance with the test goal.

In light of the above construction, we find Appellant's arguments unavailing. We also additionally note that the Examiner's makes a finding of inherency by stating, "[c]ontrary, to Appellant's belief [Farchi's] test <u>has</u> to include a sequence of tests cases." (Ans. 8, emphasis added). Appellant has not rebutted the Examiner's responsive arguments in the Answer by availing themselves of the opportunity to file a Reply Brief. "Silence implies assent." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 572 (1985).

As noted above, we find that Farchi discloses a test suite that is run on a program. (FF 1-2). We further find that the test suite comprises one or more test cases for each component of interest. (FF 3). Thus, we agree with the Examiner that Farchi discloses a "test map" within the meaning of representative claim 1.

CONCLUSIONS

1. Appellant has not shown the Examiner erred in concluding that claims 9-13 are directed to non-statutory subject matter under 35 U.S.C. §101.

2. Appellant has not shown the Examiner erred in finding that Farchi discloses providing at least one test script to conduct a test at each module and each interface point. (Claim 1).

3. Appellant has not shown the Examiner erred in finding that Farchi discloses a "test map" as claimed. (Claim 1).

DECISION

We affirm the Examiner's decision rejecting claims 9-13 under 35 U.S.C. §101.

We affirm the Examiner's decision rejecting claims 1-20 under 35 U.S.C. § 102(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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